

### **E.) REMARKS**

This Response is filed in response to the Office Action dated November 13, 2003.

Upon entry of this Response, claims 44-80 will be pending in the Application.

In the outstanding Office Action, the Examiner indicated that claims 30-43 were withdrawn; rejected claims 23-26 under 35 U.S.C. 101; rejected claims 1-7 and 23-29 under 35 U.S.C. 102(e) as being anticipated by Herz et al. (U.S. Patent Application Publication No. 2001/0014868); and rejected claims 8-22 under 35 U.S.C. § 103(a) as being unpatentable over Herz et al. (U.S. Patent Application Publication No. 2001/0014868) in view of Fenton et al. (U.S. Patent Application Publication No. 2002/0035840).

#### **Rejection under 35 U.S.C. 101**

The Examiner rejected claims 23-26 under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Specifically, the Examiner stated that

The basis of this rejection is set forth in a two prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete and tangible result.

For a claimed to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" and therefore are found to be non-statutory subject matter. For a method claim to pass the muster, the recited method must somehow apply, involve, use, or advance the technological arts.

In the present case the inventive concept in claim 23 only recites an abstract idea. The recited step providing at least on database of personalized information transmitting personalized information ... etc. do not apply, involve, use or advance the technological arts since all the steps can be performed in the mind of the user or by use of pencil and paper and no specific technology (e.g. computer, processor) is expressly recited in the body of the claims. ...

Although the recited method produces a useful, concrete and tangible result, since the claimed invention, as a whole, [is] not within the technological arts as explained above, claim 23 deemed to be directed to non-statutory subject matter.

Claims 23-26 have been cancelled herein thereby rendering the rejection thereagainst moot. However, in order to further prosecution of the Application, Applicant will respond to the Examiner's rejection in view of newly presented claim 68, which is also a method claim like canceled claim 23. Applicant submits that newly presented claim 68 is directed to statutory subject matter because the invention as recited in the claim is directed to the technological arts and produces a useful concrete and tangible result. Specifically, the claim recites the step of transmitting the generated personalized information to a portable display unit and that the portable display unit has a transceiver, at least one database, a user interface, a display screen, a microprocessor, and at least one program executable by the microprocessor. Since the claim recites the use of specific technology, e.g., the portable display unit and components, Applicant submits that claim 68 is within the technological arts and thus, is directed to statutory subject matter.

In conclusion, Applicant respectfully submits that the claims are directed to statutory subject matter and are therefore allowable.

**Rejection under 35 U.S.C. 102**

The Examiner rejected claims 1-7 and 23-29 under 35 U.S.C. 102(e) as being anticipated by Herz et al. (U.S. Patent Application Publication No. 2001/0014868), hereinafter referred to as "Herz."

Specifically, the Examiner stated that

As per claims 1, 23 and 24 Herz et al teach a system/method for providing to at least one user in a commercial establishment personalized information relevant to the commercial establishment, the system comprising: at least one database comprising the personalized information; at least one transmitter for transmitting the personalized information to a user; and at least one receiver for receiving, storing, and displaying the personalized information to the user (*see fig 1, paragraphs 0021, 0022, 0024*).

Claims 1-7 and 23-29 have been cancelled herein thereby rendering the rejection thereagainst moot. However, in order to further prosecution of the Application, Applicant will respond to the Examiner's rejection in view of the newly presented claims.

Herz, as understood, is directed to a system for determining which products a purchaser would be most likely to buy, and which offering price and promotions (coupons, advertisements, etc.) can be expected to maximize the vendor's profitability. The system is primarily used in an

“on-line” environment and determines the products and offers to present to the purchaser based on the profile of the purchaser or shopper, which profiles of the shoppers are automatically constructed based on their demographics, and history of information request and purchases.

In contrast, newly presented independent claim 44 recites a system for providing personalized information to a user in a commercial establishment, the system comprising: at least one database storing information related to a user; a portable display unit operated by a user in a commercial establishment, the portable display unit having a unique identifier, and the portable display unit comprising a transceiver, at least one database, a user interface, a display screen, a microprocessor, and at least one program executable by the microprocessor to enable the portable display unit to receive, store, and display information to a user in a commercial establishment; a location tracking system to determine a location of the portable display unit in a commercial establishment; a server computer, the server computer being in communication with the location tracking system and the at least one database and the server computer being configured to generate personalized information for a user in a commercial establishment based on the location of the portable display unit and the information related to a user stored in the at least one database; and at least one transceiver in communication with the server computer for transmitting the personalized information generated by the server computer to the portable display unit.

Newly presented independent claim 68 recites a method of providing personalized information to a user in a commercial establishment, comprising the steps of: storing information related to a user in at least one database; determining a location of a user in a commercial establishment with a location tracking system; generating personalized information for a user in a commercial establishment based on the location of a user in a commercial establishment and the information related to a user stored in the at least one database; and transmitting the generated personalized information to a portable display unit operated by a user in a commercial establishment, the portable display unit having a transceiver, at least one database, a user interface, a display screen, a microprocessor, and at least one program executable by the microprocessor to enable the portable display unit to receive, store, and display the personalized information to a user in a commercial establishment.

Several of the features recited by Applicant in independent claims 44 and 68 are not taught or suggested by Herz. First, Herz does not teach or suggest a location tracking system or determining the location of a user as recited by Applicant in independent claims 44 and 68. In addition, Herz does not teach or suggest generating personalized information for a user in a commercial establishment based on the location of a user in a commercial establishment and the information related to a user stored in the at least one database as recited in by Applicant in independent claims 44 and 68. As discussed above, the system in Herz makes determinations based on the profile of the shopper. Thus, since Herz does not teach or suggest all of the limitations recited in independent claims 44 and 68, Applicant respectfully submits that Herz does not anticipate Applicant's invention as recited in independent claims 44 and 68.

Therefore, for the reasons given above, independent claims 44 and 68 are believed to be distinguishable from Herz and therefore are not anticipated nor rendered obvious by Herz.

Dependent claims 45-67 and 69-80 are believed to be allowable as depending from what are believed to be allowable independent claims 44 and 68 for the reasons given above. In addition, claims 45-67 and 69-80 recite further limitations that distinguish over the applied art. In conclusion, it is respectfully submitted that claims 44-80 are not anticipated nor rendered obvious by Herz and are therefore allowable.

### **Rejection under 35 U.S.C. 103**

The Examiner rejected claims 8-22 under 35 U.S.C. § 103(a) as being unpatentable over Herz in view of Fenton et al. (U.S. Patent Application Publication No. 2002/0035840), hereafter referred to as "Fenton."

Specifically, the Examiner stated that

As per claim 8, Herz et al teach a system for providing personalized information to a user in a commercial establishment, comprising least one database comprising personalized information, at least one transmitter for transmitting the personalized information to the user; and at least one receiver for receiving, storing, and displaying personalized information, wherein the at least one transmitter is in communication with the location tracking system and the location tracking system is in communication with the receiver. (*see fig 1, paragraphs 0021, 0022, 0024*). Herz et al fail to teach a location tracking system and a transmitter is in communication with the location tracking system and the location tracking system is in communication with the receiver. However, Fenton et al teach a location tracking system and a transmitter is in communication with the location tracking system and the location tracking system is in communication

with the receiver (*see abstract, figs 1,2 paragraphs 0009, 0012*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Herz et al's inventive concept to include Fenton et al's location tracking system and a transmitter is in communication with the location tracking system and the location tracking system is in communication with the receiver because this would have the collection of valuable information and thus make proper user of the available location information.

Claims 8-22 have been cancelled herein thereby rendering the rejection thereagainst moot. However, in order to further prosecution of the Application, Applicant will respond to the Examiner's rejection in view of the newly presented claims.

Herz is directed to a system for determining which products a purchaser would be most likely to buy as discussed in greater detail above.

Fenton, as understood, is directed to the determining of a precise position of a mobile user using a GPS positioning system.

In contrast, newly presented independent claim 44 recites a system for providing personalized information to a user in a commercial establishment as described in greater detail above and newly presented independent claim 68 recites a method of providing personalized information to a user in a commercial establishment as described in greater detail above.

Several of the features recited by Applicant in independent claims 44 and 68 are not taught or suggested by Herz and/or Fenton. First, Herz and Fenton do not teach or suggest a unique identifier for the portable display unit as recited by Applicant in independent claims 44 and 68. Neither of the systems in Herz and Fenton discusses a portable unit having a unique identifier. The system in Herz discusses determining the identity of the user to make its determinations and the system in Fenton does not discuss an identifier for the GPS receiver.

Furthermore, Applicant respectfully submits that the Examiner has improperly combined Herz and Fenton. The Examiner has provided no teaching or suggestion in Herz that would indicate the desirability of incorporating into Herz the GPS positioning system of Fenton, nor has the Examiner cited any passage in Fenton that would indicate that the GPS positioning system of Fenton can be used in the product determination system of Herz. The Examiner makes a statement that it would be advantageous to make proper use of the available location information. However, the Examiner provides no support for this conclusion in either Herz or Fenton. Thus, Applicant respectfully submits that the Examiner has reached his conclusion

based on the teachings in Applicant's specification, which is impermissible hindsight reasoning by the Examiner.

In addition, Applicant respectfully submits that the proposed combination of the Examiner is not operable. The Examiner states that it would be obvious to include the location tracking system of Fenton in the product determination system of Herz. However, the location tracking system of Fenton would not be able to provide accurate and reliable information to the system of Herz because it is well known in the art that GPS location determinations within a building, such as the commercial establishment recited by Applicant, are problematic and very unreliable. Furthermore, even if Fenton could provide reliable location information, the processing time involved in Fenton in determining the location information would make it impractical for use with Herz because by the time the location information from Fenton is provided to the system in Herz, the user will most likely have changed locations in the commercial establishment thereby rendering the information out-of-date.

Therefore, in view of the above, claims 44-80 are believed to be distinguishable from Herz and/or Fenton and therefore are not anticipated nor rendered obvious by Herz and/or Fenton. In addition, claims 44-80 recite further limitations that distinguish over the applied art. In conclusion, it is respectfully submitted that claims 44-80 are not anticipated nor rendered obvious by Herz and/or Fenton and are therefore allowable.

**Information Disclosure Statement**

In the outstanding Office Action, the Examiner attached an Information Disclosure Statement submitted by Applicant on June 8, 2001. However, the Examiner did not attach a copy of a second Information Disclosure Statement submitted by Applicant on September 26, 2002. It is believed that the Examiner has considered this second Information Disclosure Statement based on the Examiner's application of a reference from the second Information Disclosure Statement and the Examiner's characterization of that reference as "applicant admitted prior art." (Note: Applicant disagrees with the Examiner's characterization of the reference as "admitted prior art.") Applicant requests that the Examiner confirm that the second Information Disclosure Statement from September 26, 2002 has been considered by the Examiner and provide Applicant with a copy of the second Information Disclosure Statement initialed by the Examiner as being considered. If the Examiner has not considered the second

Information Disclosure Statement, Applicant requests that the Examiner consider the references in the second Information Disclosure Statement and provide Applicant with a copy of the second Information Disclosure Statement initialed by the Examiner.

**Newly Added Claims**

Claims 44-80 are newly added by the Response to further define Applicant's invention. It is submitted that no new matter has been added by the new claims because support for the claims can be found in the specification and in the canceled claims. Claims 44-80 are believed to be allowable for the reasons set forth greater detail above.

**CONCLUSION**

In view of the above, Applicant respectfully requests reconsideration of the Application and withdrawal of the outstanding rejections. As a result of the amendments and remarks presented herein, Applicant respectfully submits that claims 44-80 are not anticipated by nor rendered obvious by Herz, Fenton or their combination and thus, are in condition for allowance. As the claims are not anticipated by nor rendered obvious in view of the applied art, Applicant requests allowance of claims 44-80 in a timely manner. If the Examiner believes that prosecution of this Application could be expedited by a telephone conference, the Examiner is encouraged to contact the Applicant.

The Commissioner is hereby authorized to charge any additional fees and credit any overpayments to Deposit Account No. 50-1059.

Respectfully submitted,  
**McNEES, WALLACE & NURICK**

By



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